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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,366	09/11/2003	Keith G. Lurie	016354-005400US	5478

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EXAMINER

RAGONESE, ANDREA M

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/660,366

Applicant(s)

LURIE ET AL.

Examiner

Andrea M. Ragonese

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3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 18, 19 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I, **claims 1-19 and 35**, in the reply filed on August 19, 2004, is acknowledged.
2. Examiner acknowledges that **claims 20-34** have been canceled.
3. Applicant's election with traverse of Species I-A, **claims 1-17**, in the reply filed on August 19, 2004 is acknowledged. The traversal is on the ground(s) that "each of claims 1-19 and 35 relate to enhancing venous return to the heart by extracting respiratory gases from the airway to create an intrathoracic vacuum." This is not found persuasive because Species I-A (**claims 1-17**) is a method which requires a completely different search than the methods found in Species I-B (**claims 18-19 and 35**) because the methods of Species I-B require different steps in order to carry out those methods, such as "repeatedly compressing the person's chest" and "preventing or impeding respiratory gases from flowing to the person's lungs". Therefore, the restriction requirement between different species is still deemed proper and is made **FINAL**.
4. **Claims 18-19 and 35** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 19, 2004.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-10 and 13-15** are rejected under 35 U.S.C. 102(b) as being anticipated by Lurie et al. (US 5,692,498). Lurie et al. discloses a method for enhancing venous return to the heart (column 13, lines 8-24) by:

- delivering a positive pressure breath to a person using a ventilation bag;
- actively extracting respiratory gases from the person's airway following the positive pressure breath to create an intrathoracic vacuum to enhance venous return to the hearts; and
- repeating the steps of delivering a positive pressure breaths and extracting respiratory gases;
- wherein a threshold valve is configured to open when the negative intrathoracic pressure exceeds about  $-7$  cm H<sub>2</sub>O, which falls within the range of  $-5$  cm H<sub>2</sub>O and  $-60$  cm H<sub>2</sub>O (claims 1, 3, 9, 26 and 31).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claims 11-12 and 16-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lurie et al. (US 5,692,498), as applied to **claim 1** above, in view of Orr et al. (US 2001/0029339 A1). Lurie et al. discloses an apparatus comprising all the limitations recited in **claims 11-12 and 16-17**, with the exception of measuring at least one physiological parameter of a person or the volume of positive pressure breath and then transmitting measured information to a remote receiver. However, the use of this type of measurement and information transmission was known at the time the invention was made. Specifically, Orr et al. teaches the use of "sensing and/or monitoring devices" for "detecting respiratory flow parameters during inhalation and exhalation" in

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combination with "data recording and display equipment" in order to "calculate the cardiac output or pulmonary capillary blood flow of the patient" (paragraph [0017]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Lurie et al. by adding monitoring and/or measuring devices that are capable of transmitting the measured information to a receiver because it is well known in the art, as taught by Orr et al., to sense and/or monitor different parameters and transmit the information to a receiver in order to monitor a patient during ventilation and make adjustments accordingly.

### ***Conclusion***


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Andrea M. Ragonese** whose telephone number is **571-272-4804**. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:30 pm.

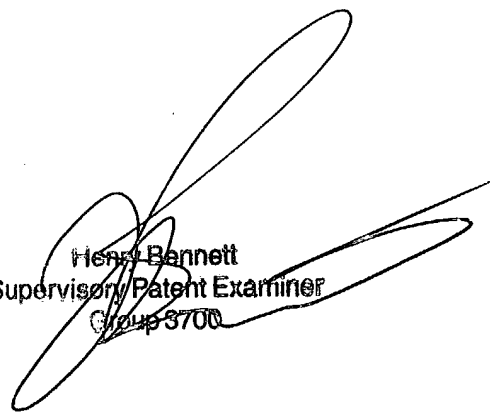
12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMR   
November 29, 2004

  
Henry Bennett  
Supervisory Patent Examiner  
Group 3700